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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,704	12/27/2001	Thomas E. Murphy	BS01-286	9260

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EXAMINER
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VAN HANDEL, MICHAEL P

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/026,704

Applicant(s)

MURPHY ET AL.

Examiner

Michael Van Handel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/07/2006 has been entered.

### *Response to Amendment*

1. This action is responsive to an Amendment filed 11/07/2006. Claims 19-31 are pending. Claims 19, 22, 23, 29, 30 are amended. Claims 1-18 are canceled.

### *Response to Arguments*

1. Applicant's arguments with respect to claims 19 and 30, filed 11/07/2006, have been considered, but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **19-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over DeWeese et al. in view of Mimura et al.

Referring to claims **19, 22, 29, and 30**, DeWeese et al. discloses a set top box integrated with, or communicating with, a television, the set top box comprising:

- a first input receiving an audio signal (p. 3, paragraph 56);
- a first output adapted to be received by the television (p. 4, paragraph 65 & Fig. 1A);
- a second output adapted to be received by a second set top box (p. 3, paragraph 57);
- a second input adapted to receive audible message information (p. 9, paragraphs 101, 105; & Fig. 10); and
- a back channel communications path that is different from the first input (the examiner notes that the chat server 88 is connected to television distribution facility 16 via communications network 86, so the back channel path is different from the first input)(p. 5, paragraph 71 & Fig. 2A).

DeWeese et al. further discloses transmitting video chat images with audio as real-time communications by the chat system (p. 10, paragraph 107, 111 & Fig. 11). DeWeese et al. still further discloses that the video chat images and audio can be shown at the same time as a television program (p. 11, paragraphs 119, 120; & Figs. 16, 17). DeWeese et al. does not disclose that the audio signal is processed for an audio channel and the audible message information is processed for another audio channel and a volume of the audio signal is reduced below a volume of the received audible message information being played. Mimura et al. discloses a television audio/visual (A/V) conferencing system with a database 12. The AV database stores combinations of video signal characteristics and corresponding audio signal

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processing parameters, such as a volume of sound to be reproduced and a balance between sounds reproduced by loudspeakers (col. 9, l. 10-35). The processing parameters are read from the database and supplied to an audio signal processor to control the sound field to produce an acoustic space suitable for an image, by changing the sound volume and right and left balance to localize sounds based on the locality of displayed images (col. 6, l. 13-23; col. 20, l. 22-62; & Figs. 32A-33). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the video and audio chat system of DeWeese et al. to include changing the sound volume and right and left balance of received audio messages to be output from different speakers, such as that taught by Mimura et al. in order to provide a real-time TV conferencing system with improved reality (Mimura et al. col. 3, l. 36-45). The combination of DeWeese et al. and Mimura et al. does not teach reducing a volume of the audio signal below a volume of the received audible message information. August et al. discloses a set-top box 30 for receiving A/V and telephone signals. When a television viewer receives a telephone call over the set-top box, the audio signal emanating from the video receiving device can be automatically muted or reduced to a selectable level (col. 2, l. 46-64). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the combination of DeWeese et al. and Mimura et al. to include reducing the volume of a television audio signal upon receiving a audio message, such as that taught by August et al. in order to provide the automatic interaction of desirable activities (August et al. col. 2, l. 56-68).

Referring to claims 20 and 21, the combination of DeWeese et al., Mimura et al., and August et al. teaches a set top box according to claims 19 and 30, respectively, wherein the message information comprises at least one of video information, text information, and a pre-

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formatted message (the examiner notes that chat sessions can have text, audio, video, or a combination, as well additional appended information)(DeWeese et al. p. 3, paragraph 55; p. 4, paragraph 64; & p. 14, paragraph 141).

NOTE: The USPTO considers the applicant's "at least one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claims **23** and **25**, the combination of DeWeese et al., Mimura et al., and August et al. teaches the set top box according to claims 30 and 19, respectively, further comprising a memory storing pre-made voice messages (the examiner notes that chat sessions can be stored and viewed at a later time)(DeWeese et al. p. 4, paragraph 64).

Referring to claim **24**, the combination of DeWeese et al., Mimura et al., and August et al. teaches the set top box according to claim 19, wherein the message information is retrieved from a memory device (DeWeese et al. p. 5, paragraph 69).

Referring to claim **26**, the combination of DeWeese et al., Mimura et al., and August et al. teaches the set top box according to claim 19, further comprising a message waiting indicator (the examiner notes that when a message is received it appears in region 206)(DeWeese et al. p. 8, paragraph 93 & Fig. 9).

Referring to claims **27** and **31**, the combination of DeWeese et al., Mimura et al., and August et al. teaches the set top box according to claims 19 and 30, respectively, further comprising another input adapted to receive information from a keyboard (DeWeese et al. p. 5, paragraph 67 & Fig. 1B).

Referring to claim **28**, the combination of DeWeese et al., Mimura et al., and August et al. teaches the set top box according to claim 19, wherein the first input also receives a video

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signal (DeWeese et al. p. 3, paragraph 56) and the set top box modifies the video signal to display a text message (DeWeese et al. p. 8, paragraph 93 & Fig. 9).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MVH



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